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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/064,264

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Jason A. Gordon

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EXAMINER

JABR, FADEY S

ART UNIT

PAPER NUMBER

3628

MAIL DATE

DELIVERY MODE

10/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/064,264	Applicant(s) GORDON, JASON A.	
	Examiner FADEY S. JABR	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims **1-15** have been cancelled. Claim **16** has been amended. Claims **16-20** remain pending and are again presented for examination.

Summary of Board Decision

The Examiner's decision to reject claim 19 under 35 U.S.C. § 112, second paragraph, is reversed.

The Examiner's decision to reject claims 1, 10, and 16-19 under 35 U.S.C. § 102(b) is affirmed.

The Examiner's decision to reject claims 2-9, 11-13, and 20 under 35 U.S.C. § 103(a) is affirmed.

In addition to affirming the Examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (2007). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

Response to Arguments

1. Applicant's arguments filed 21 August 2008 with respect to 35 U.S.C. 101 have been fully considered but they are not persuasive. Applicant's amendments have not overcome the underlying issue of claim 16 which is the fact that a "carrier information system" is not deemed

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to be an apparatus or device, as stated on page 20 of the Board's Decision. Therefore, offering the customer the incentive by updating a rate database maintained by the carrier information system for the customer, does not overcome the rejection (1) since the information system is not deemed to be an apparatus; (2) merely updating a database which is **maintained** by the carrier information system does not necessarily involve the use of the system. Thus, the rejection is upheld.

2. Applicant's arguments with respect to claims **16-20** have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims **16-20** are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Claimed Invention the claimed invention is directed to a methodology for determining how to target incentives. In other words, the claimed invention is directed to a method of making a decision to provide and modify incentives.

The Specification does not appear to define any of the claim terms. As such, they are to be given their ordinary and customary meaning. In that regard, claim 16 is a collection of obtaining, determining, offering, and analyzing steps involving the use of data for reaching a particular decision.

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obtaining, determining, offering, and analyzing steps involving the use of data for reaching a particular decision.

We are cognizant that claim 16 includes the generic term "information carrier system." The information carrier system is not disclosed as a particular machine or device in the Specification. As such, the claim is not limited to a method of using a machine or device, i.e., a method of using the information carrier system. In addition, the "information carrier system" does not effect a transformation of any subject matter of the claim and thus add nothing to the non-statutory status of the claimed method as a whole. Even if we were to assume *arguendo* that the "information carrier system" is a machine, as has been stated informatively, "[n]ominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process." *Ex parte Langemyr*, Appeal No. 2008-1495, slip op. at 20 (BPAI May 28, 2008). As the panel in *Langemyr* stated, "[t]o permit such a practice would exalt form over substance and permit claim drafters to file the sort of process claims not contemplated by the case law." *Id.* Because the subject matter of claim 16 does not transform or otherwise reduce subject matter into a different state or thing, it is not directed to a statutory "process." Dependent method claims 17-20 likewise fail this test for the same reasons.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims **16-20** rejected under 35 U.S.C. 103(a) as being unpatentable over Barns-Slavin et al., U.S. Patent No. 5,995,950 in view of Kende et al., Pub. No. US2002/0120540 A1, hereinafter referred to as Barns-Slavin and Kende, respectively.

As per **Claim 16 and 19**, Barns-Slavin et al. disclose a mailing machine comprising:

- obtaining customer usage and customer data (C. 2, lines 7-10; C. 4, lines 48-50);
- determining whether offering an incentive is desired (C. 4, lines 19-25);
- determining whether a customer is eligible for an incentive (C. 2, lines 20-47);
- obtaining incentive related usage data (C. 2, lines 7-10);
- analyzing the incentive related usage data (C.2, lines 20-67).

Barns-Slavin fails to *explicitly* disclose offering the customer the incentive *by updating a rate database maintained by the carrier information system for the customer*; determining effectivity *of the incentive*; determining whether to modify the incentive *based on the effectivity of the incentive*; and modifying the incentive *by updating the customer's rate database*. However, Barns-Slavin discloses offering the customer an incentive, determining whether to modify the incentive (C. 2, lines 20-67).

Further Kende teaches rates may be updated at the occurrence of an identified triggering event (0057-0061). Further, Kende teaches an analysis engine which determines one or more preferred rate plans based on one or more prior usage information (0063-0073). Moreover, Kende teaches a switching module which can inform whether their rate plan is the most advantageous (0082-0083).

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It would have been obvious to one of ordinary skill in the art to include in the mailing system of Barns-Slavin the ability update and examine discounts and incentives given to customers as taught by Kende since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **Claim 17**, Barns-Slavin disclose a mailing machine comprising:

- the customer usage data is obtained from a mailing machine (Col. 2, lines 7-10).

As per **Claim 18**, Barns-Slavin further discloses a mailing machine wherein:

- the incentive is a time based discount for at least one particular class of mail
(Col. 2, lines 7-10).

6. Claim **20** is rejected under 35 U.S.C. 103(a) as being unpatentable over Barns-Slavin in view of Kende as applied to claim 16 above, and further in view of Sansone et al., U.S. Patent No. 5,072,401, hereinafter referred to as Sansone.

As per **Claim 20**, Barns-Slavin further discloses a mailing machine wherein:

- determining whether an incentive is desired includes, analyzing historical usage data
(Col. 2, lines 7-10; Col. 4, lines 19-25).

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Barns-Slavin fails to *explicitly* disclose analyzing partial period usage data. However, Barns-Slavin discloses analyzing usage data (Col. 2, lines 7-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the mailing machine of Barns-Slavin and include analyzing partial period usage data, because it greatly improves the efficiency of the system by providing the system with more accurate rate data to determine the discount for the user.

Barns-Slavin fails to disclose forecasting capacity demands and targeting at least one customer likely to require the applicable mailing services to be discounted. However, Sansone teaches using logistics planning in order to ensure timely delivery of mailings, and also targets mailers with common usage patterns (Col. 3, lines 50-65; Col. 16, lines 3-6). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the mailing machine of Barns-Slavin and include forecasting capacity demands and targeting customers with common usage patterns as taught by Sansone, because it greatly improves the system by enabling a more efficient and effective use of the facilities of the post office.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FADEY S. JABR whose telephone number is (571)272-1516. The examiner can normally be reached on Mon. - Fri. 8:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fadey S Jabr
Examiner
Art Unit 3628

FSJ

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/F. S. J./
Examiner, Art Unit 3628

/JOHN W HAYES/
Supervisory Patent Examiner, Art Unit 3628